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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,016	03/12/2001	Evgenyi Y. Shalaev	PC10807ACJG	1570

7590

04/28/2003

Gregg C. Benson  
Pfizer Inc.  
Patent Department, MS 4159  
Eastern Point Road  
Groton, CT 06340

EXAMINER

RUSSEL, JEFFREY E

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/805,016

Applicant(s)

SHALAEV ET AL.

Examiner

Jeffrey E. Russel

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-6 and 12-23 is/are allowed.
- 6) ☒ Claim(s) 1 and 7 is/are rejected.
- 7) ☒ Claim(s) 2 and 8-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The disclosure is objected to because of the following informalities: At page 6, line 4, "comprise lyoprotectants" should be two words. Appropriate correction is required.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Carden (U.S. Patent No. 4,714,609). Carden teaches contacting skin, which comprises solid-state proteins including keratin and collagen, with a skin tanning composition comprising vanillin. See, e.g., the Abstract. Vanillin is a methoxysalicylaldehyde. The sun emits ionizing radiation. Because the same solid-state protein is being contacted with the same methoxysalicylaldehyde according to the same method steps, inherently the solid-state proteins in the skin of Carden will be protected from ionizing radiation to the same extent claimed by Applicants.
4. Applicant's arguments filed March 24, 2003 have been fully considered but they are not persuasive.

Applicants did not respond to the objection to the specification set forth in paragraph 1 of the previous Office action and repeated above.

The rejections set forth in paragraphs 2, 3, 5, and 8-10 of the previous Office action are withdrawn in view of the amendments to the claims and for the reasons given by Applicants in their response. The rejection set forth in paragraph 6 of the previous Office action is withdrawn in view of Applicants' argument that the claimed formulations do not embrace ones in which a complex forms between the methoxysalicylaldehyde and the protein.

The rejection based upon Carden is maintained. With respect to method claim 1, the sun does produce ionizing radiation which reaches the skin. See Pelle et al at column 1, lines 29-31,

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and Bernstein at column 1, lines 36-40. Tanning is not the only effect which the sun's radiation has on the skin and the human body. With respect to product claim 7, a difference in intended use does not impart patentability to composition claims where the composition is otherwise anticipated by the prior art. Prior to exposure to the sun's radiation, the vanillin of Pelle et al and the skin proteins will be present in combination as is required by Applicants' claim. It is also noted that Applicants have not demonstrated that their claimed formulation will not undergo the same tanning reaction which occurs in Carden. The ionizing radiation which is present in Carden is a different type of radiation than that used in Applicants' examples. Accordingly, the difference between Carden's formulation and Applicants' claimed formulation is not yet established.

5. Claims 3-6 and 12-23 are allowed. Claims 2 and 8-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

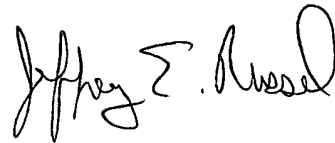
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Brenda Brumback can be reached at (703) 306-3220. The fax number for Art Unit 1654 for formal communications is (703) 305-3014; for informal communications such as proposed amendments, the fax number (703) 746-5175 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.

A handwritten signature in black ink, appearing to read "Jeffrey E. Russel". The signature is stylized with a large, looped "J" and a cursive "Russel".

Jeffrey E. Russel

Primary Patent Examiner

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JRussel

April 25, 2003